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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,070

05/19/2006

Toru Shimizu

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EXAMINER

MOORE, WALTER A

ART UNIT

PAPER NUMBER

1783

MAIL DATE

DELIVERY MODE

09/30/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,070	<b>Applicant(s)</b> SHIMIZU ET AL.	
	<b>Examiner</b> WALTER MOORE	<b>Art Unit</b> 1783	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,11-14,16-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8, 11-14, 16-20, 23, and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/2010 has been entered.

### ***Status of Claims***

2. Claims 1, 3-6, 8, 11-14, 16-20, 23, and 24 are pending. Claims 1, 3, 17, 18-20, 23, and 24 were amended in the response filed on 8/9/2010. Claims 2, 7, 9-10, 15, 21, and 22 were previously canceled.

### ***Withdrawn Rejections***

3. The objection to claim 3, made of record in the office action mailed on 5/10/2010, has been withdrawn due to applicant's amendment filed on 8/9/2010.

4. The 35 USC 103 rejections of claims 1, 3-6, 8, 13-14, and 17-20 as being obvious over Ishida et al., USPN 6,570,010, in view of Furman, 5,451,404, made of record in the office action mailed on 5/10/2010, have been withdrawn due to applicant's amendment filed on 8/9/2010.

5. The 35 USC 103 rejections of claims 11-12, 16, and 23-24 as being obvious over Ishida et al., USPN 6,570,010, in view of Furman, 5,451,404, and Kaplan, USPA 2002/0182296, made

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of record in the office action mailed on 5/10/2010, have been withdrawn due to applicant's amendment filed on 8/9/2010.

## **REJECTIONS**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

7. Claims 1, 3-6, 8, 13-14, 17-19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al., USPN 6,570,010, in view of Ishida et al., WO 2003/074622. The rejection refers to Ishida et al., USPA 2005/0129721, which is being used as the English language equivalent of Ishida et al., WO 2003/074622 (cited in the IDS filed on 5/19/2006).

Regarding claims 1, 6, 8, 13-14, and 17-20, Ishida '010 discloses a beverage (carbonated beverage, col. 9, ln. 36) comprising a concentrated fruit juice component (lemon juice concentrate, col. 9, ln. 46), a base with sweetness (liquid sugar dextrose, col. 9, ln. 47), and a flavor improving substance (vanillyl-n-butyl ether, col. 9, ln. 49).

Ishida '010 suggests the flavor improving substance (vanillyl-n-butyl ether) can be mixed with food and drink beverages (col. 4, ln. 66) that include cool-feeling substances (col. 4, ln. 56) and refreshing feeling substances (col. 4, ln. 61). Ishida '010 suggests cool- and refreshing feeling substances including: menthol, 3-(1-menthoxy)propane-1,2-diol, paramenthane-3,8-diol, 3-(1-menthoxy)-2-methylpropane-1,2-diol (col. 4, ln. 57-60). Ishida '010 discloses the

combination improves the duration and cool-feeling or refresh-feeling imparting effect (col. 4, ln. 60-62).

However, Ishida '010 does not expressly disclose the beverage includes a combination of cool-feeling substances and refreshing feeling substances (presently claimed as menthol).

Ishida '721 is drawn to cool feeling compositions having a high cooling effect (p. 1, para 0001). Ishida '721 discloses it is known in the art to combine two or more cool feeling substances to enhance cooling effect (p. 1, para 0005). Ishida '721 discloses the composition is useful in food and drink compositions (p. 1, para 0011). Ishida '721 discloses the composition includes menthol combined with 3-1-menthoxypropane-1,2-diol (p. 2, para 0019).

Regarding the amount of the menthol and cool-feeling substance in claims 1 and 4, Ishida '721 discloses a food and drink composition comprises between 0.001 and 20% by weight of the total cool feeling composition (p. 2, para 0025). Furthermore, Ishida '721 prepared an example cool feeling composition having 35% menthol and 2% 3-1-menthoxypropane-1,2-diol (p. 10, Table 1, Example 1). This suggests between 0.00000035 and 0.007 parts menthol and 0.00000002 and 0.0004 parts 3-1-menthoxypropane-1,2-diol per 1000 parts of the food composition. Sample calculation:  $0.001\% \times 35\% = 0.00035\%$  or 0.00000035 parts per 1000 parts of the total food composition.

It would have been obvious to one of ordinary skill in the art at the time of invention to add menthol and cool-feeling substances, as taught in Ishida '721, to the beverage composition, taught in Ishida '010, to obtain a beverage composition comprising menthol and cool feeling substances. One of ordinary skill in the art would have been motivated to use a combination of

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menthol and cool feeling substances because they a cooling effect having excellent persistency in food and drink compositions (p. 1, para 0010).

Regarding claim 3, Ishida '010 discloses the base with sweetness is dextrose (liquid sugar dextrose, col. 9, ln. 47), which is another name for D-glucose.

Regarding claim 5, Ishida '721 discloses the ratio of a refreshing feeling substance (component (A) menthol) to a cool feeling substance (component (B) 3-1-menthoxypropane-1,2-diol), is between 0:100 to 20:80 (component (A) to component (B), p. 2, para 0023). The inverse of which converts to 100:0 to 80:20 parts cool feeling substance (component (B) 3-1-menthoxypropane-1,2-diol) per refreshing feeling substance (component (A) menthol). Furthermore, Ishida '721 prepared an example having 0.057 parts of cool feeling to one part refreshing feeling substances (2 parts 3-1-menthoxypropane-1,2-diol to 35 parts 1-menthol, p. 10, Table 1, Example 1).

Regarding claims 17-20, the phrase, "for reinforcing a flavor," is a statement of intended use or purpose. A statement with regard to intended use is not further limiting as a manipulative difference between the process claimed and the prior art. In order to patentably distinguish the claimed invention from the prior art, a claimed intended use must result in a manipulative difference between the claimed invention and the prior art. See MPEP § 2111.02 II. In the present case there is no manipulative difference from the beverage, taught in Ishida '010 in view of Ishida '622 Furman, and the claimed process.

8. Claims 11-12, 16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al., USPN 6,570,010, in view in view of Ishida et al., WO 2003/074622, as applied

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to claims 1, 3-6, 8, 13-14, and 17-20 above, and further in view of Kaplan, USPA 2002/0182296.

The rejection refers to Ishida et al., USPA 2005/0129721 as the English language equivalent of Ishida et al., WO 2003/074622.

Ishida '010 in view of Ishida '721 is relied on as above. Ishida '010 in view of Ishida '721 does not disclose the beverage is a fruit juice containing dairy product.

Kaplan is drawn to carbonated milk beverages (p. 1, para 0002). Kaplan discloses the milk beverage can contain a fruit juice (p. 1, para 0002). Kaplan discloses carbonated milk products would be perceived as more healthy alternatives to soft drinks (p. 1, para 0006). It would have been obvious to one of ordinary skill in the art at the time of invention to include a milk product, as taught in Kaplan, in the fruit juice containing beverage, taught in Ishida '010 in view of Ishida '721, to obtain a fruit juice beverage containing milk. One of ordinary skill in the art would have been motivated to include milk because it is viewed as a healthy alternative to soft drinks (p. 1, para 0006).

Regarding claim 16, Ishida '010 discloses an additional flavor improving substance (vanillyl-n-butyl ether, col. 9, ln. 49).

Regarding claims 23 and 24, the phrase, "for reinforcing a flavor," is a statement of intended use or purpose. A statement with regard to intended use is not further limiting as a manipulative difference between the process claimed and the prior art. In order to patentably distinguish the claimed invention from the prior art, a claimed intended use must result in a manipulative difference between the claimed invention and the prior art. See MPEP § 2111.02 II. In the present case there is no manipulative difference from the beverage, taught in Ishida in view of Furman in view of Kaplan, and the claimed process.

***Response to Arguments***

9. Applicant's arguments, see page 12, filed 8/9/2010, with respect to Furman have been fully considered and are persuasive. The rejections over Furman have been withdrawn. As applicant explains (Remarks, p. 12), Furman was relied upon for disclosing the particular combination of substances. However, Furman fails to suggest the presently claimed invention.

10. Applicant's arguments with respect to claims 1, 3-6, 8, 13, 14, 17-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant asserts unexpected results in a fruit containing food product (Remarks, p. 12, last para). Examiner is not persuaded by this argument because Ishida '721 teaches ranges within the claimed ranges. Ishida '721 also discloses exemplary compositions that fall within the claimed ranges. Furthermore, Ishida '721 suggests overlapping ranges of the claimed compounds, i.e. menthol and 3-1-menthoxypropane-1,2-diol. The Specification used the same compounds, which form the basis of the applicant's asserted unexpected result (Specification, p. 37, last two lines to p. 38, first line). Furthermore, the prior art recognizes the claimed substances, both alone and in combination, change flavor of food and beverage compositions. Based on the disclosure, it is unclear how the recited properties are unexpected changes in the flavors of the beverages.

Examiner notes the properties on which the Applicant relies (i.e. light feeling in the mouth, continuation of light feeling, and heavy feeling of sweetness) lack definition or repeatable objective results. The Specification recites the property of light feeling in the mouth on a five point scale. The scale includes especially weak, slightly positive, strong, especially strong, and too strong (p. 39-40). However, the Specification fails to indicate any reference to

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qualify the relative comparisons on the scale. Furthermore, the Specification fails to explain the difference between any of the levels. For example, what is the difference between especially weak and slightly positive? The same rationale applies to each of the properties.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/

Walter Moore, Examiner AU 1783  
9/21/2010

/David R. Sample/

Supervisory Patent Examiner, Art Unit 1783